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09/687,420	10/13/2000	Peter Joseph Rock	13DVI3812	8491

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EXAMINER

CHEN, CHONGSHAN

ART UNIT PAPER NUMBER

2162

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/687,420

Applicant(s)

ROCK ET AL

Examiner

Chongshan Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-18 are pending in this Office Action.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 29, 2005 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
5. The claimed invention performs a "subjective assessment". Each time performing the assessment will have different result because the assessment is subjective. Therefore, the claims are non-statutory and are rejected under 101 as not being concrete.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose “performing a subjective assessment”.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haq et al. (hereinafter “Haq”, US 6,275,812 B1) in view of Joao (US 6,662,194 B1).

As per claim 1, Haq disclosing a method for determining candidates to interview, said method comprising the steps of:

providing pre-determined desired qualities for a candidate, the desired qualities include at least two of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills (Haq, col. 5, line 25 – col. 6, line 42, “ISDRM allows specific job functions (roles and responsibilities) in a specialty to be identified by a skills template. A skill template basically identifies the relevant importance of each skill (Weights) and the skill level (Index) required in

each skill to perform a job function. ... For example, a Circuit Design Engineer needs to have an index of 1 in Management Skills”. The examiner interprets the circuit design skill as the pre-determined desired quality of analytical ability, and the management skill as the pre-determined desired quality of interpersonal skill);

performing a subjective assessment that determines if the candidate possesses at least one of a plurality of independent characteristics, a predetermined combination of characteristics being indicative of a degree to which the candidate possesses the desired qualities (Haq, Fig. 5, col. 3, line 20 – col. 4, line 67, col. 5, line 25 – col. 6, line 42, the system determines whether the candidate possesses the circuit design skill which is the analytical ability in combination with management skill which is the interpersonal skill);

generating a database in a computer readable medium including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities (Haq, Fig. 2, element 78, Employee Database, element 79, Skills Assessment Forms);

normalizing the characteristics, normalizing includes comparing a total number of characteristics, possessed by the candidate, of a combination of characteristics that determine each desired quality, to a total number of possibly possessed characteristics for the desired quality, and assigning a value to each desired quality based on the comparison (Haq, Fig. 5-10, col. 4, line 61 – col. 5, line 5, col. 6, lines 5-61);

displaying results for each candidate based on the desired quality values (Haq, col. 10, lines 40-43, “outputs of various of request/queries to the database”).

Haq does not explicitly disclose selecting at least one candidate to interview based on the desired quality values. Joao teaches selecting at least one candidate to interview based on the

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desired quality values (Joao, col. 24, lines 22-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Haq by incorporating the means for selecting candidate to interview as disclosed by Joao (Joao, col. 24, lines 22-35). The motivation being to allow the employer to decide which candidate is the most suitable candidate for the job through the interview process.

As per claim 2, Haq and Joao teach all the claimed subject matters as discussed in claim 1, and further disclose storing the predetermined desired qualities for a candidate within the database, the desired qualities include analytical ability, self-confidence, initiative, change orientation, and interpersonal skills (Haq, Fig. 5, col. 5, line 25 – col. 6, line 42).

As per claim 3, Haq and Joao teach all the claimed subject matters as discussed in claim 1, and further disclose obtaining pre-determined desired qualities associated with each characteristic (Haq, Fig. 5, col. 5, line 25 – col. 6, line 42); and normalizing characteristics of each candidate with the pre-determined desired qualities associated with each characteristic (Haq, col. 6, lines 5-55).

As per claim 4, Haq and Joao teach all the claimed subject matters as discussed in claim 1, and further disclose summing the normalized characteristics of each candidate; and dividing the sum total of the normalized characteristics by a pre-determined value representing a total amount possible (Haq, col. 5, line 1 – col. 6, line 55).

As per claim 5, Haq and Joao teach all the claimed subject matters as discussed in claim 1, and further disclose displaying the results (Haq, col. 10, lines 40-43), which inherently includes displaying the results of the candidates in at least one of a tabular output format and a graphical output format.

Claims 6-8 rejected on grounds corresponding to the reasons given above for claims 1-3.

As per claim 9, Haq and Joao teach all the claimed subject matters as discussed in claim 6, and further disclose

rank each candidate based on normalized characteristics (Haq, Fig. 11); and

sum the normalized characteristics of each candidate (Haq, col. 5, line 1 – col. 6, line 55).

As per claim 10, Haq and Joao teach all the claimed subject matters as discussed in claim 9, and further disclose divide the sum total of all normalized characteristics by an amount representing a pre-determined possible total (Haq, col. 5, line 1 – col. 6, line 55).

As per claim 11, Haq and Joao teach all the claimed subject matters as discussed in claim 6, and further disclose displaying the results (Haq, col. 10, lines 40-43), which inherently includes displaying the results of the candidates in at least one of a tabular output format and a graphical output format.

Claims 12-13 are rejected on grounds corresponding to the reasons given above for claims 1-2.

As per claim 14, Haq and Joao teach all the claimed subject matters as discussed in claim 12, and further disclose normalizing the characteristics, said processor further programmed with pre-determined desired qualities associated with each characteristic (Haq, col. 5, line 25 – col. 6, line 61).

As per claim 15, Haq and Joao teach all the claimed subject matters as discussed in claim 12, and further disclose normalize the characteristics, said processor further programmed to normalize candidate characteristics with known qualities associated with each characteristic (Haq, col. 5, line 25 – col. 6, line 61).

As per claim 16, Haq and Joao teach all the claimed subject matters as discussed in claim 12, and further disclose summing the normalized characteristics of each candidate; and dividing the sum total of the normalized characteristics by an amount representing a predetermined possible total (Haq, col. 5, line 1 – col. 6, line 61).

As per claim 17, Haq and Joao teach all the claimed subject matters as discussed in claim 16, and further disclose displaying the results (Haq, col. 10, lines 40-43), which inherently includes displaying the results of the candidates in a tabular output format.

As per claim 18, Haq and Joao teach all the claimed subject matters as discussed in claim 16, and further disclose displaying the results (Haq, col. 10, lines 40-43), which inherently includes displaying the results of the candidates in a graphical output format.

### *Response to Arguments*

10. Applicant's arguments filed on August 29, 2005 have been fully considered but they are not persuasive.

11. As per applicant's arguments regarding the references do not teach selecting at least one candidate to interview based on the desired quality values have been considered but are not persuasive. Haq teaches determining whether a candidate processes the desired quality values/skills, and selecting a candidate based on the desired quality values/skills (Haq, col. 5, line 25 – col. 6, line 67). Joao teaches the employer proceed with the employment screening, interview (Joao, col. 24, lines 22-35). The Haq and Joao combined system teaches selecting candidate to interview based on the desired quality values/skills. Therefore, the arguments are not persuasive.



12. Applicant traverse the assertion in the Office Action that “the examiner interprets the circuit design skill as the predetermined desired quality of analytical ability, and the management skill as the pre-determined desired quality of interpersonal skill”. Examiner argues that the claims must be given their broadest reasonable interpretation (MPEP 2111). A circuit designer must have the skill to design the circuit, and s/he must have the ability to analyze the requirement of a circuit, and have the ability to analyze and solve any problems encountered during the circuit design. Management skill is a type of interpersonal skill because the person need to communicate with other person, and identify any problems between people, and solve the problem. These interpretations are consistent with the interpretation that those skilled in the art would reach. Furthermore, the applicant is reminded that the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the arguments are not persuasive.

13. As per applicant's arguments regarding the references do not teach generating a database including at least one characteristic for each candidate wherein the at least one characteristic is correlative to the desired qualities have been considered but are not persuasive. Haq teaches generating a database including at least one characteristic for each individual wherein the at least one characteristic is correlative to the desired qualities (Haq, Fig. 2, element 78, Employee Database, element 79, Skills Assessment Forms, Fig. 5-7. Fig. 5-7 show whether engineer 1, 2 and 3 possess certain characteristic correlative to the desired qualities). Therefore, the argument is not persuasive.

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14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Haq teaches determining whether a candidate processes the desired quality values/skills, and selecting a candidate based on the desired quality values/skills (Haq, col. 5, line 25 – col. 6, line 67). Joao teaches the employer proceed with the employment screening, interview (Joao, col. 24, lines 22-35). The Haq and Joao combined system teaches selecting candidate to interview based on the desired quality values/skills. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Haq by incorporating the means for selecting candidate to interview as disclosed by Joao (Joao, col. 24, lines 22-35). The motivation being to allow the employer to decide which candidate is the most suitable candidate for the job through the interview process.


#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571) 272-4031. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen  
October 16, 2005



JEAN M. CORRIELUS  
PRIMARY EXAMINER